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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,973	02/25/2004	Toshiaki Igarashi	03500.100142.	8991
5514 7590 05/11/2010 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
NGUYEN, CINDY				
ART UNIT		PAPER NUMBER		
2161				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/784,973

**Applicant(s)**

IGARASHI, TOSHIAKI

**Examiner**

CINDY NGUYEN

**Art Unit**

2161

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/16/2010 has been entered.

### ***Response to Arguments***

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 12 and 13 recited "A computer-readable medium". However, "A computer readable medium" is reasonable interpretation to a computer readable medium covers forms of non-transitory tangible media and transitory propagating signals per se and is not limited to tangible embodiments. As such, the claim is not limited to statutory subject matter and is therefore non-statutory. The Examiner

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suggests amending claim 58 to narrow the claim to cover only statutory embodiments to avoid a reject under 35 USC § 101 by adding the limitation "non-transitory" the claim. (see MPEP 2106).

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-13, 15 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Naitoh et al. (US 200400103325, hereafter Naitoh).

The applied reference has a common Assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

As to claims 1,2,6,9, 12 and 13, Naitoh teaches a network device that receives a search request transmitted from data processing apparatuses , performs a search for network devices in response to receiving the search request, and transmits device lists

indicating the network devices found by performing the searches to the data processing apparatuses, the network device managing apparatus (see paragraph 0012) comprising:

a first receiving unit adapted to receive the data processing apparatus, a first search request for a first search for network devices, and identification information identifying the data processing apparatus that transmitted the first search request (**i.e., transmits and receives information to and from the LAN 101, when receiving a query for device identification information, including an IP address and MAC address ...**(see paragraphs 0051; 0060 and further such as devices 102 being managed are connected are searched for by SNMP broadcast for which an MIB that allows for identification of a device is used, such as SYsObjectID, then information including at least an IP address (first device identification information) and a MAC address (second device identification information) that issued from each device 102, see paragraph 0064 );

a first searching unit adapted to perform the first search for network devices in response to the first search request received by the first receiving unit (**i.e., devices 102 being managed are connected are searched for by SNMP broadcast for which an MIB that allows for identification of a device is used, such as SYsObjectID, then information including at least an IP address (first device identification information) and a MAC address (second device identification information) that issued from each device 102** this corresponding to a first searching unit, **see paragraphs 0064; 0078-0080 );**

storage unit adapted to store the device list indicating network devices found by performing the first search, the first device list being associated stored in association with identification information identifying the data processing apparatus that transmitted the search request (i.e., **stored in a database of the device management computer 103 or database of database remote 120 as device list as fig. 7, see paragraphs 0076; 0082; 0085 and fig. 7, Naitoh**);

a second receiving unit adapted to receive, from the data processing apparatus, a second search request for a second search for network devices and identification information identifying the data processing apparatus that transmitted the second search request (i.e., **transmits and receives information to and from the LAN 101, when receiving a query for device identification information, including an IP address and MAC address ... (see paragraphs 0051; 0060 and further such as devices 102 being managed are connected are searched for by SNMP broadcast for which an MIB that allows for identification of a device is used, such as SYsObjectID, then information including at least an IP address (first device identification information) and a MAC address (second device identification information) that issued from each device 102 this corresponding to a second searching unit, see paragraph 0064** );

a second searching unit adapted to perform a second search for network devices in response to the second search request received by the second receiving unit (i.e., **devices 102 being managed are connected are searched for by SNMP broadcast for which an MIB that allows for identification of a device is used, such as**

**SYsObjectID, then information including at least an IP address (first device identification information) and a MAC address (second device identification information) that issued from each device 102, see paragraphs 0064; 0078-0080 );**

obtaining unit adapted to use the identification information received by the second receiving unit as a key obtain from among device lists stored in the storage unit, the first device list associated with the received identification information identifying the data processing apparatus that transmitted the first search request (i.e., **determined in step s503 that the IP address of found device 102 is being managed, and whether the MAC address obtained by searching in step 502 ...see paragraph 0068**), if the identification information received by the second receiving unit is equal to the identification information associated with the first device list by the storage unit, the first device list indicating a search result provided by the first search unit (i.e., **when it is determined that they match each other, a determination is made in step s507 as to whether checking of all found devices has bee completed...see paragraph 0069, 0072, Naitoh**);

a comparing unit adapted to compare a second search result provided by the second searching unit with the first search result indicated by the first device list obtained by the obtaining unit (i.e., **comparing a first device identification information and second device identification information which are obtained form the device 102 , see paragraphs 0066; 0068; 0069; 0084-0089; 0126; 0127; , Naitoh**);

forming unit adapted to specify one or more the network devices found by performing the second search by said second searching unit but not present in the first search result indicated by the first device list obtained by the obtaining unit **(i.e., when a new device is confirmed see paragraphs 0069; 0131, Naitoh);**

Transmitting unit adapted to transmit the second device list formed by the forming unit to the data processing apparatus that transmitted the second search request **(i.e., see paragraphs 0081; 0084; 0100, lines 9+, Naitoh).**

As to claims 3 and 10, Naitoh teaches wherein the device list formed by the forming unit indicates at least one of information regarding whether printing is possible and an error state **(i.e., notification such as paper Jam, see paragraphs 0087; 0115, Naitoh).**

As to claims 4, 7 and 11, Naitoh teaches wherein the device list formed by the data forming means includes an emphasis mark to emphasize **(i.e., specifically notify service personnel of what device is causing a failure... see paragraph 0087; 0115 and fig. 10, Naitoh).**

As to claims 5 and 8, Naitoh teaches wherein the device list formed by the data forming means includes instruction data for allowing a device icon of the data processing apparatus that transmitted the second search request to be displayed in an



updated state (i.e., **notification change information include IP address and MAC address in fig. 10 and 11, Naitoh**).

As to claims 15 and 17, Naitoh teaches wherein the identification information is a network address of the data processing apparatus (i.e., **IP address, MAC, paragraph 0051, Naitoh**).

#### Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy Nguyen whose telephone number is 571-272-4025. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. N./  
Examiner, Art Unit 2161  
/A Oberley/  
Primary Examiner, Art Unit 2100